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FRED ZOLLINGER III			NGUYEN, THUY-VI, THI	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/776,583	Applicant(s) LAX, MICHAEL
	Examiner THUY-VI NGUYEN	Art Unit 3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 April 2010.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-43; 61-69 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-43; 61-69 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/23/10 has been entered.
2. This is in response to the applicant's communication filed on 04/27/10, wherein:
Claims 1-43; 61-69 are currently pending;
Claims 44-60 have been cancelled;
Claims 1, 32 have been amended;
Claims 61-69 have been added.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has added limitations to this claims related to "a circuit deactivator configured to permanently interrupt electrical communication within said circuit". Examiner has reviewed applicant's disclosure and submits that the added feature "permanently" finds no support in the specification as currently written and is, therefore, directed to new matter. Applicant's specification appears to discloses "the deactivator configured to interrupt electrical communication within the circuit" as shown on pars. 0017, 0054-0055 of the application publication. However, this limitation does not include "the circuit deactivator permanently interrupt electrical communication within said circuit".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-31, 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over FARRAR ET AL (US 2004/0123311) in view of BRADY ET AL (US 5,939,984).**

As for independent claim 1, FARRAR ET AL discloses an apparatus for use with a benefit denial system, said apparatus comprising:

a containing element configured to receive an asset {see at least figure 1, 10, pars. 0002 discloses cases/container for holding disk shape data carriers, e.g. CD and DVD}; a security tag enclosed within the containing element configured to communicate

information from inside the containing element {see figures 1-3, abstract pars. 0096-0097}.

However, FARRAR ET AL does not explicitly disclose that the tag is the circuit comprising an antenna associated with the containing element

BRADY cites the feature of the RFID tag with the circuit for used in an article surveillance system include the antenna is connected the chip 34 containing the tag memory {see figures 1-4, col. 3, lines 26-38 and lines 59-67; col. 4, lines 1-25}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the electrical security tag of FARRAR ET AL to substitute the circuit and antenna feature in an RFID tag as taught by BRADY in order to improve a security system with the tag be read at distance and do not required a line of sight between tag and reader.

Note that Note: that it appears that independent claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be

employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Note: as for the limitation "*to receive an asset and a lock having a locked condition that prevents access to the benefit of the asset*", "*information that unlocks the lock....the lock of asset*" are considered as the intended use of the containing element and the electrical circuit, an antenna within the containing element.

However, the containing element of FARRAR ET AL/ BRADY is also capable of receiving an asset that have a lock condition that prevents access to the benefit by a user of the asset; and the electrical circuit comprises an antenna of FARRAR ET AL/ BRADY is capable of communicate information to a receiver outside said containing element. Further the fact that information unlocks the lock of asset, this is the function of structure that is not positively recited in the system claim.

As for dep. claims 2-5, FARRAR ET AL/ BRADY discloses a locking element configured to lock the containing element in a closed state, and the circuit is affixed to said locking element, and affixed to containing element; said locking element is removable from said containing element {see FARRAR ET AL abstract, figures 1-4, "the lockable security device 8", at least pars. 0094, 0133, 0135}

As for dep. claim 6, FARRAR ET AL/ BRADY discloses said electrical circuit is disposed inside said containing element when said containing element is closed; and said electrical circuit is configured to communicate said information {see FARRAR ET AL at least figs. 1-4}.

As for dep. claim 7, FARRAR ET AL/ BRADY discloses said circuit comprises a data storage device {see BRADY see figure 1-4, "tag memory 14"}.

As for dep. claim 8, FARRAR ET AL/ BRADY discloses said circuit is further configured to communicate said information when said asset is enclosed within said containing element {see at least figs. 1-4}. Further the fact that information communicate in the circuit, this is the function of structure that is not positively recite in the system claim.

As for dep. claims 9-19, which deals with the asset include the type of benefit in the asset which is considered as intended use limitation of the containing element in the containing element. However the containing element of FARRAR ET AL/ BRADY is capable of receiving an asset include the type of benefit in an asset. {see FARRAR ET AL/ BRADY, at least figures 1-4} and further the fact that information/data is required by said system to provide said benefit, this is the function of structure that is not positively recited in the system claim.

As for claims 20-21, which discloses the well known type of material of the containing element e.g. opaque or solid material. It is noted that this type of material is common, old and well known in the art and would have been obvious to one of ordinary skill to use this material for making the container, for example, CD or DVD case. Furthermore, this is fairly taught in FARRAR ET AL, par. 0198

As for claim 22, which deals with type communication using a radio frequency signal, this is taught in FARRAR ET AL/ BRADY {see BRADY figures 1-4; col. 3, lines 25-38}.

As for independent claim 23, which carries the similar limitation as the rejected independent claim 1 above, therefore it is rejected for the same reason sets forth independent claim 1 as indicated above. Further the fact that information is configured to be sued by said system to execute said conveyance, this is noted as the function of structure that is not positively recited in the system claim.

As for dep. claim 24, FARRAR ET AL/ BRADY discloses said electrical circuit is disposed inside said containing element when said containing element is closed; and said electrical circuit is configured to communicate said information {see FARRAR ET AL at least figs. 1-4}.

As for dep. claim 25, FARRAR ET AL/ BRADY discloses said circuit is further configured to communicate said information when said asset is enclosed within said containing element {see at least figs. 1-4}. Further the fact that information communicate in the circuit, this is the function of structure that is not positively recite in the system claim.

As for dep. claims 26-31, which deals with how information is configured by the circuit device which is considered as intended use of the circuit device and the electrical circuit of FARRAR ET AL/ BRADY is capable of communication information. Further the fact that this function of the structure is not positively recited in the system claim.

As for independent claim 61, FARRAR ET AL discloses an apparatus for use with a benefit denial system, said apparatus comprising:

a containing element that includes a container body and a locking element;

{see at least figure 1, 10, abstract pars. 0002 discloses cases/container for holding disk shape data carriers, e.g. CD and DVD; "the lockable security device 8", at least pars. 0094, 0133, 0135};

the container body being movable between open and closed states {see figures 1-4};

the locking element having a locked and unlocked states; the locking element being carried by the container body and disposed within the container body when the container body is in the closed state and the locking element is in the locked state;

{see FARRAR ET AL abstract, figures 1-4, "the lockable security device 8", at least pars. 0094, 0133, 0135}

an electrical tag having a circuit and being carried by the locking element

{see figures 1-3, abstract pars. 0096-0097};

a security tag enclosed within the containing element configured to communicate information from inside the containing element {see figures 1-3, abstract pars. 0096-0097};

However, FARRAR ET AL does not explicitly disclose that the tag is the circuit comprising an antenna associated with the containing element

BRADY cites the feature of the RFID tag with the circuit for used in an article surveillance system include the antenna is connected the chip 34 containing the tag memory {see figures 1-4, col. 3, lines 26-38 and lines 59-67; col. 4, lines 1-25}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the electrical security tag of FARRAR ET AL to

substitute the circuit and antenna feature in an RFID tag as taught by BRADY in order to improve a security system with the tag be read at distance and do not required a line of sight between tag and reader.

Note: It appears that independent claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Therefore, as for the limitation "*the container body being configured to receive an asset; the asset having a benefit for a user; being adapted to communicate with a system....the asset*" are considered as the intended use of the container body and the electrical circuit with an antenna.

However, the containing element include a container body of FARRAR ET AL/ BRADY is also capable of receiving an asset that have a benefit for a user of the asset; and the electrical circuit comprises an antenna of FARRAR ET AL/ BRADY is capable of communicate with a system to provide a user access to the benefit of the asset.

Further the fact that the feature of "communicate with a system", this is the function of structure that is not positively recited in the system claim.

As for dep. claim 62, FARRAR ET AL/ BRADY discloses the locking element is removable form the container body {see FARRAR ET AL abstract, figures 1-4, "the lockable security device 8", at least pars. 0094, 0133, 0135}.

As for dep. claim 63 discloses an asset is a media disc which is an intended use of the container body, and the container body of FARRAR ET AL/ BRADY is capable of receiving an asset which is a media disc {see FARRAR ET AL pars. 0003-0004}.

As for dep. claim 64, FARRAR ET AL/ BRADY discloses the electrical circuit and antenna are configured to communicate using a radio frequency signal {see BRADY col. 26-38}.

7. Claims 65-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over FARRAR ET AL (US 2004/0123311) in view of BRADY ET AL (US 5,939,984) and further in view of HODES (US 2002/0088855).

As for independent claim 65, FARRAR ET AL discloses an asset security system comprising:

a containing element that includes a container body and a locking element; {see at least figure 1, 10, abstract pars. 0002 discloses cases/container for holding disk shape data carriers, e.g. CD and DVD; "the lockable security device 8", at least pars. 0094, 0133, 0135};

the container body being movable between open and closed states {see figures 1-4};

the locking element having a locked and unlocked states; the locking element being carried by the container body and disposed within the container body when the container body is in the closed state and the locking element is in the locked state; {see FARRAR ET AL abstract, figures 1-4, "the lockable security device 8", at least pars. 0094, 0133, 0135}

an asset having a benefit being carried by the container body {see figure 27, at least pars. 0033, 0203}

an electrical tag having a circuit and being carried by the locking element {see figures 1-3, abstract pars. 0096-0097};

However, FARRAR ET AL does not explicitly disclose that the tag is the circuit comprising an antenna associated with the containing element;

BRADY cites the feature of the RFID tag with the circuit for used in an article surveillance system include the antenna is connected the chip 34 containing the tag memory {see figures 1-4, col. 3, lines 26-38 and lines 59-67; col. 4, lines 1-25}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the electrical security tag of FARRAR ET AL to substitute the circuit and antenna feature in an RFID tag as taught by BRADY in order to improve a security system with the tag be read at distance and do not required a line of sight between tag and reader.

The combination of FARRAR ET AL/ BRADY discloses the claimed invention above. FARRAR ET AL/ BRADY does not explicitly disclose "an access device that communicates with the electrical circuit to provide a user access/unlock to the benefit of the asset".

The system of HODES discloses a benefit denial system include an access device (transceiver) that communicate with the smart chip to provide a user access to the benefit of the asset {see pars. 0007, 0083, discloses the smart chip is attached within the CD package which can be read by an appropriate device at point of purchase and transmits to a platform or facility provided the control number and or other data related to the PIN and/or associated with the smart chip. Once transmitted, the control number or data related to the PIN or PINS are activated at the platform or facility. The receipt of the transaction is then sent to the verification or authorization entity. and pars. 0107-0110 disclose when the unlocking process or encrypted codes of the asset by verifying the PINS number that are provided at the point of purchase.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the RFID tag containing the antenna, and a chip that attach within the container/package of FARRAR ET AL/ BRADY to include an access device to communicate with the electrical circuit in the smart chip to unlock the asset as taught by HODES for the benefit of improving the antitheft system even if when the asset get stolen, it still won't be used without unlocking the asset.

As for dep. claims 66-67, FARRAR ET AL/ BRADY/ HODES discloses the access device is a transceiver and communicates with the circuit to provide the access {see HODES pars. 0007, 0083}.

As for independent claims 68-69, basically these claims carry similar limitation as rejected independent claim 65 above. They are rejected for the same reason sets forth independent claim 65 as indicated above.

8. **Claims 32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over FARRAR ET AL (US 2004/0123311) in view of BRADY ET AL (US 5,939,984) and further in view of MASON (US 6,809,645)**

As for independent claim 32, FARRAR ET AL discloses a container comprising:

a containing element configured to receive an asset {see at least figure 1, 10, pars. 0002 discloses cases/container for holding disk shape data carriers, e.g. CD and DVD}; a security tag enclosed within the containing element configured to communicate information from inside the containing element {see figures 1-3, abstract pars. 0096-0097}.

However, FARRAR ET AL does not explicitly disclose that the tag is the circuit comprising an antenna associated with the containing element

BRADY cites the feature of the RFID tag with the circuit for used in an article surveillance system include the antenna is connected the chip 34 containing the tag memory {see figures 1-4, col. 3, lines 26-38 and lines 59-67; col. 4, lines 1-25}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the electrical security tag of FARRAR ET AL to substitute the circuit and antenna feature in an RFID tag as taught by BRADY in order to improve a security system with the tag be read at distance and do not required a line of sight between tag and reader.

Note that Note: that it appears that independent claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Note: as for the limitation "*to receive an asset", "information corresponding to said asset*" are considered as the intended use of the containing element and the electrical circuit, an antenna within the containing element.

However, the containing element of FARRAR ET AL/ BRADY is also capable of receiving an asset that have a lock condition that prevents access to the benefit by a user of the asset; and the electrical circuit comprises an antenna of FARRAR ET AL/

BRADY is capable of communicate information to a receiver outside said containing element. Further the fact that information unlocks the lock of asset, this is the function of structure that is not positively recited in the system claim.

FARRAR ET AL/ BRADY discloses claimed invention as indicated above, except for the circuit deactivator configured permanently interrupt electrical communication within the circuit.

MASON discloses the tags which are attached to articles included radio frequency tags, magnetic tags. The radio frequency tags may be *disconnected to deactivate the tag* by altering the characteristic of the electrical circuit in a tag {see col. 2, lines 5-26}; surveillance tag (EAS) deactivator for deactivating surveillance tags (EAS tags, RFID tag) at the checkout station {see figure 2A, 3 and 4A, {col. 7, lines 39-67; col. 8, lines 1-5}.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of FARRAR ET AL/ BRADY by including a circuit deactivator to deactivate the tag as taught by MASON in order to detect a surveillance tag attached to an article being processed at a checkout station and modifying a surveillance tag indicator in a product record of a product database in response to the surveillance tag present signal {see col. 4, lines 42-52; col. 5, lines 30-39}.

As for dep. claim 33, FARRAR ET AL discloses said electrical circuit is disposed inside said containing element when said containing element is closed; and

said electrical circuit is configured to communicate said information {see FARRAR ET AL at least figs. 1-4}.

As for dep. claim 34, which discloses with the circuit is configured to communicate said information when said asset is enclosed within said containing element {{see at least figs. 1-4}. Further the fact that information communicate in the circuit, this is the function of structure that is not positively recite in the system claim.

As for dep. claim 35, which discloses the interrupt electrical signal communication between two circuit devices, this is fairly taught in MASON {see col. 4, lines 42-52; col. 9, lines 59-66}.

As for dep. claims 36-37, which discloses the data storage and the antenna in the circuit {see BRADY figures 1-4, col. 26-37}.

AS for dep. claims 38-39, which discloses the deactivator is configured to interrupt said electrical communication by physically separating the first and second portions of circuit, and the deactivator is configured to be operated manually {see MASON, col. 1, lines 55-67, col. 2, lines 1-27}.

As for dep. claims 40-43 which deal with the information is configured to be used by a benefit system, and by an asset transaction system which is considered as intended use of the circuit device and the electrical circuit of FARRAR ET AL/ BRADY is capable of communication information. Further the fact that this function of the structure is not positively recited in the system claim.

Response to Arguments

Applicant's arguments with respect to claims 1-43, 61-69 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689

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